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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,663	08/29/2001	Akiko Sato	NITT.0031	4771
38327	7590	09/09/2005	EXAMINER	
REED SMITH LLP 3110 FAIRVIEW PARK DRIVE, SUITE 1400 FALLS CHURCH, VA 22042			ZHEN, WEI Y	
			ART UNIT	PAPER NUMBER
			2191	

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,663

Applicant(s)

SATO ET AL.

Examiner

Wei Y. Zhen

Art Unit

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 13-21 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Hohle US

Patent No. 6,199,762.

As Per Claim 13, Hohle teaches that a system generally for personalizing and synchronizing smartcard data in the context of a distributed transaction system is disclosed. A dynamic smartcard synchronization system comprises access points configured to initiate a transaction in conjunction with a smartcard, an enterprise data collection unit, and a card object database update system. CODUS interfaces with personalization system in order to facilitate reissuance of the card by providing updated data in the event a card is destroyed, lost, or stolen. (E.g. see Abstract and associated text). In that Hohle discloses the method that covering the steps of a smart card system comprising: “a smart card issuance/management system configured to perform issuance and management of a smart card” (e.g. see FIG.9, card management system 902 and associated text); “smart card service providing/managing system configured to perform issuance and management of an application loaded on the smart card, wherein the smart card

Art Unit: 2191

issuance/management system and the smart card service providing/managing system are operatively connected to each other through a network (e.g. see FIG. 1, enterprise networks 114 and associated text) such that information exchange is achieved by transmitting and receiving electronic messages through the network, each of the electronic messages is uniquely identified using a message ID (e.g. see col. 3:61-62, initialization data (e.g., account numbers, serial numbers, default preferences, and the like)), data of the smart card issuance/management system and the smart card service providing/managing system is stored using the message ID as a key (e.g. see col. 3:61-62, initialization data (e.g., account numbers)), and the information exchange between the smart card issuance/management system includes at the time of initial issuance of the smart card, the smart card issuance/management system sending an application loading permission which permits the smart card service providing/managing system to load an application (e.g. see FIG. 9 and associated text, i.e. see col. 3:57-67), at the time of the initial issuance of the smart card, the smart card service providing/managing system sends the application loading permission and the application and loads the application in the smart card (e.g. see col. 9:57-65 and see FIG. 9 and associated text, i.e. see col. 3:57-67), and at the time of the reissuance of the smart card, the smart card service providing/managing system receives the card attribute data from the smart card, sends the card attribute information and an application ID of the application to the smart card issuance/management system, the smart card issuance/management system searches the message ID of the application loading permission using the sent card attribute information which identifies the smart card and sends the message ID of the application loading permission to the smart card service providing/managing system (e.g. see col. 9:57-65 and see FIG. 9 and associated text, i.e. see col. 3:57-67, col. 9:25-50), and

Art Unit: 2191

the smart card service providing/managing system searches an examination result at the time of initial loading application using the message ID as the key (e.g. see col. 9:57-65 and see FIG. 9 and associated text i.e. see col. 3:57-67).

See the previous office action for the rejection to claims 14-21.

Response to Arguments

3. Applicant's arguments filed 4/11/2005 have been fully considered but they are not persuasive.

In the remark, applicant has argued:

1) Hohle does not disclose, teach or suggest the characteristics of the invention as now recited in at least claim 13 wherein, at the time of reissuance of the smart card, the service providing/managing system receives the card attribute data from the smart card which identifies the smart card, sends the card attribute data and an application ID of the application, receives the message ID of the application loading permission, and searches an examination result at the time of initial loading application using the message ID as the key.

2) Hohle does not disclose, teach or suggest the characteristics of the invention as now recited in claim 16 wherein "the data of the smart card issuance/management system and the smart card service providing/managing system is stored using the message ID as a key" and "the smart card issuance/management system sends the message ID of the application loading permission."

3) Hohle does not disclose, teach or suggest the characteristics of the invention as now recited in claim 19 wherein, "the data of the smart card issuance/management system and the smart card service providing/managing system is stored using the message ID as a key" and

Art Unit: 2191

"the smart card service providing/managing system searches an examination result at the time of initial loading application using the message id as a key."

Examiner's response:

1) Examiner disagrees. Hohle does disclose at the time of reissuance of the smart card, the service providing/managing system receives the card attribute data from the smart card which identifies the smart card, sends the card attribute data and an application ID of the application, receives the message ID of the application loading permission, and searches an examination result at the time of initial loading application using the message ID as the key (e.g. see col. 9:57-65 and see FIG.9 and associated text, i.e. see col. 3:57-67 and col. 9:25-50. Note that initialized data (account number, serial numbers, default preference, etc) and a list of default card member preferences corresponding to the desired applications are the card attribute data and ID of the application.)

2) Examiner disagrees. Hohle does disclose "the data of the smart card issuance/management system and the smart card service providing/managing system is stored using the message ID as a key" and "the smart card issuance/management system sends the message ID of the application loading permission (col. 3:57-67 and col. 9:25-50. Note that the initialized data and a list of default card member preferences are the message ID).

3) Examiner disagrees. Hohle does disclose this limitation (see col. 3:57-67. Note that the initialized data are the message ID, and results are inherently searched at the time of initial loading).

Conclusion

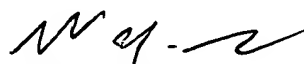
Art Unit: 2191

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wei Y. Zhen whose telephone number is (571) 272-3708. The examiner can normally be reached on Monday-Friday, 8 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wei Zhen


WEI Y. ZHEN
PRIMARY EXAMINER